



Attorney Docket 088305-0121

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Paul Levi WILLIAMS, Jr., et al.
Title: PROVISION OF ELECTRONIC COMMERCE SERVICES
Application No.: 09/741,994
Filing Date: 12/22/2000
Examiner: M. A. Cuff
Art Unit: 3627
Confirmation No.: 7764

SECOND REPLY BRIEF UNDER 37 C.F.R. § 41.41

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Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

The following is the Appellants' Second Reply Brief under 37 C.F.R. § 41.41, which is being filed in response to the Examiner's Response to Appellants' First Reply Brief mailed on July 7, 2006. It should be noted that this second reply brief supplements the Appeal Brief filed on August 2, 2005, Revised Appeal Brief filed November 17, 2005, the First Reply Brief filed on June 21, 2006, and all the arguments presented therein are incorporated herein in their entirety.

As required by MPEP 1208, the following sections are provided on separate pages herein: Status of Claims; Grounds of Rejection to be Reviewed on Appeal; and Argument.

Status of Claims

The present appeal is directed to claims 1-28, which are the claims under consideration. A copy of the pending claims 1-28 were attached in the Claims Appendix (Section 12 of Appeal Brief).

Claims 1, 2, 10, 13-16, 19, 20, 24, 27, and 28 are finally rejected under 35 U.S.C. § 102(a) as being anticipated by www.ediconsulting.com (document from website dated October 14, 1999; hereafter “EdisonConsulting”). Claims 3-9, 11, 12, 17, 18, 21-23, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over www.ediconsulting.com, in view of U.S. patent no. 5,913,210 (“Call”), U.S. patent no. 5,862,325 (“Reed”), and U.S. patent no. 6,408,292 (“Bakalash”).

Grounds of Rejection to be Reviewed on Appeal

The issue on appeal is whether the examiner erred in rejecting claims 1, 2, 10, 13-16, 19, 20, 24, 27, and 28 under 35 U.S.C. § 102(a) as being anticipated by EdisonConsulting and in rejecting claims 3-9, 11, 12, 17, 18, 21-23, 25, and 26 under 35 U.S.C. § 103(a) as being unpatentable over EdisonConsulting in view of Call, Reed, and Bakalash.

Argument

Applicants herein incorporate by reference the arguments presented in the revised appeal brief filed on November 17, 2005, as well as the arguments presented in the Reply Brief filed on June 21, 2006.

1. Clarification Re: "Automatic Determination" Support in the Specification

With respect to the comments made in the Examiner's Response to Appellants' First Reply Brief mailed on July 7, 2006 concerning page 20, lines 20-27 of the specification, Appellant apologizes for this error, whereby the discussion should have been made with respect to page 6, lines 20-27 of the specification, which states that the trading partner "knows" what trading formats and applications are acceptable to the trading partner; presents as options only those products and services that are acceptable to the trading partner; and then provides information in the form of Return On Investment (ROI) calculations and recommends product and service purchases to the user. None of these functions is performed manually, in sharp contrast to the manual process disclosed in EdisonConsulting.

2. Applicants reiterate that the inherency relied on by the examiner does not meet the legal requirements for inherency.

It is clear that EdisonConsulting requires an EDI expert to be directly involved in the process of determining EDI compatibility with a trading partner, and as such, no automatic determination is made by a host server in the system of EdisonConsulting.

In view of above, appellants respectfully solicit the Honorable Board of Patent Appeals and Interferences to reverse the rejection of the pending claims and pass this application on to allowance.

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge deposit account No. 19-0741 for any such fees; and applicants hereby petition for any needed extension of time.

Respectfully submitted,

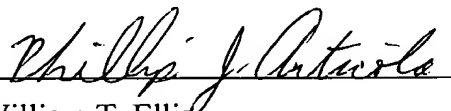
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